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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,632	10/26/2001	Susan M. Milberger	020375-000230US	9798
20350 7590 07/24/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER CHANDLER, SARA M	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 07/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No: 10/045,632	Applicant(s) MILBERGER ET AL.	
	Examiner Sara Chandler	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8, 10-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/23/06, 06/26/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 10/045,632 (10/26/01) filed on 06/07/07.

Information Disclosure Statement

The information disclosure statement filed 01/23/06 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Due to the voluminous nature of the IDS submissions, only a cursory review was given.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

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2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. See MPEP 2106 II C. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., “for _____”), but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result (e.g., “for _____”), but does not result in a structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as “*if, may, might, can could*”, as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as “*wherein, whereby*”, that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a

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particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Claim Objections

Claim 21 objected to because of the following informalities: "the second handlers is chosen" should be -- the second handlers are chosen --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the available first handlers". There is insufficient antecedent basis for this limitation in the claim. Only a single first handler is previously referred to in the claim.

Re Claim 1, What is the significance of the first handlers that are "available"? A handler that is "available" to do something is comparable to one that is "able" or "capable" of doing something. These kinds of statements do not require anything to be done.

Only a single first handler has any role in the active steps performed by the claims. Who are the plurality of first handlers? What role do they have?

Claim 1 recites the limitation "the available first handlers are chosen from a group consisting of: at least one of a debit card handler, a bank handler, and a credit card handler". The limitation is written as a closed markush group suggesting that the "available first handlers" must be one of these options. The subsequent limitation requires that at least one of available first handlers is chose from second group that is different from the first group. The claim is indefinite because these limitations conflict.

For purposes of claim interpretation, the claim has been interpreted as having only one first handler.

Re Claim 21, What is the significance of "at least one available second handler is chosen from a second group"? A handler that is "available" to do something is comparable to one that is "able" or "capable" of doing something. These kinds of statements do not require anything to be done.

Re Claim 21, What is the significance of the plurality of second handlers? Only a single second handler has any role in the active steps performed by the claims. Who are the plurality of second handlers? What role do they have?

Claim 21 recites the limitation "the second handlers is chosen from a group consisting of: at least one of a debit card handler, a bank handler, and a credit card handler". The limitation is written as a closed markush group suggesting that the "second handler" must be one of these options. The subsequent limitation requires that at least one of second handler is chosen from second group that is different from the first group. The claim is indefinite because these limitations conflict.

For purposes of claim interpretation, the claim has been interpreted as having only one second handler.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett, US Pat. No. 5,677,955 in view of Bator, US Pat. No. 6,575,362 and Perazza, US Pat. No. 5,326,959.

Re Claim 1: Doggett discloses a method comprising:

receiving pay-out instructions at a server computer system from a wide-area computer network coupled to a payor, wherein the pay-out instructions are chosen from a group consisting of at least two of a payee, a delivery location, and the credit amount (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13)

The phrase "at least two of" is interpreted as any combination of two or more of the group but, not necessarily all members of the group. See MPEP § 2111.;

determining a first handler associated with the payor (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13), wherein:

the available first handlers are chosen from a group consisting of:

at least one of a debit card handler, a bank handler, and a credit card handler (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

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transferring the credit amount from the first handler to the online system (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13); determining a second handler for preparation of a payment instrument according to the pay-out instructions (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13); and sending the pay-out instructions to the second handler (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Doggett fails to explicitly disclose wherein the payment instrument is a money order;

and at least one available first handler is chosen from a second group consisting of a promotion handler and a money order handler.

Bator discloses wherein the payment instrument is a money order (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 - col. 10, line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Doggett by adopting the teachings of Bator to provide wherein the payment instrument is a money order. As suggested by Doggett one would have been motivated to provide substitutes for checks that were safer and posed less of a security risk.

Perazza discloses:

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at least one available first handler is chosen from a second group consisting of a promotion handler and a money order handler(Perazza, col. 1, line 1+ - col. 3, line 57; col. 5, lines 15-25; col. 7, lines 9-53; col. 8, lines 28-35; col. 13, lines 60+ - col. 14, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Doggett by adopting the teachings of Perazza to provide at least one available second handler is chosen from a second group consisting of a promotion handler and a money order handler. One would have been motivated to provide the payor and payee with safer and more trusted means of transfer.

Re Claim 2: Doggett in view of Bator and Perazza discloses the claimed method supra and Doggett further discloses wherein the delivery location is chosen from a group consisting of an agent location and an address of the payee (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Re Claim 3: Doggett in view of Bator and Perazza discloses the claimed method supra and Bator discloses a method further comprising steps of:

receiving the pay-out instructions at the second handler (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 – col. 10, line 30);

printing the money order according to the pay-out instructions (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 – col. 10, line 30); and

sending the money order to the delivery location (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 - col. 10, line 30).

Re Claim 4: Doggett in view of Bator and Perazza discloses the claimed method supra and Bator discloses a method further comprising steps of:

receiving the pay-out instructions at the second handler (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 - col. 10, line 30);

printing the money order according to the pay-out instructions (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 - col. 10, line 30); and

holding the money order at the second handler for pick-up by the payee (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 - col. 10, line 30).

Re Claim 5: Doggett in view of Bator and Perazza discloses the claimed method supra and Doggett discloses a method further comprising a step of storing the credit amount in a stored value fund associated with one of the payor and the payee (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Re Claim 6: Doggett in view of Bator and Perazza discloses the claimed method supra and Bator further discloses, wherein the second handler is an agent location capable of

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printing money orders (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 – col. 10, line 30).

The phrase “capable of printing money orders” is interpreted as having the ability to print money orders but, not necessarily doing so. See MPEP § 2111

Re Claim 7: Doggett in view of Bator and Perazza discloses the claimed method supra and Doggett discloses a method further comprising steps of:

creating a temporary stored value fund for the payee (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13); and

storing the credit amount in the stored value fund (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Re Claim 8: Doggett in view of Bator and Perazza discloses the claimed method supra and Doggett discloses a method further comprising steps of:

storing the credit amount in a first stored value fund associated with the payor (Doggett,

abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13); and

transferring the credit amount from the first stored value fund to a second stored value fund associated with the payee (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Claims 10-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett, US Pat. No. 5,677,955 in view of "Paying Electronic Bills Electronically," by Lawrence J. Radecki and John Wenninger. Current Issues in Economics and Finance. Volume 5, Number 1. (January 1999). (hereinafter Radecki).

Re Claims 10: Doggett discloses a method for transferring a credit amount out of an online system using a payment instrument, the method comprising:

receiving pay-out instructions at a server computer system from a wide- area computer network coupled to a payor, wherein the pay-out instructions include at least two of a payee, a delivery location, and the credit amount (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13)

The phrase "at least two of" is interpreted as any combination of two or more of the group but, not necessarily all members of the group. See MPEP § 2111.;

determining a first handler associated with the payor (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

transferring the credit amount from the first handler to the online system (Doggett,

abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

creating a temporary stored value fund for one of the payor and the payee if a stored value fund does not exist for the one (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15;

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col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

storing the credit amount in the temporary stored value fund (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20;

col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

determining a second handler for preparation of the payment instrument according to

the pay-out instructions (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+

- col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

sending the pay-out instructions to the second handler (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20;

col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13); and

transferring the credit amount from the temporary stored value fund to the second

handler (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31;

col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col.

18, line 13).

Doggett fails to explicitly disclose:

wherein the temporary stored value fund is the online system.

Radecki discloses:

wherein the temporary stored value fund is the online system (Radecki, pgs. 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Doggett by adopting the teachings of Radecki to provide wherein the temporary stored value fund is the online system.

As suggested by Radecki, one would have been motivated to reduce paper records, speed the process, produce cost savings and aid in convenience.

Re Claim 11: Doggett in view of Radecki discloses the claimed method supra and Doggett further discloses, wherein the payment instrument is chosen from the group consisting of: a money order, a cashiers check, a tellers check, a certified check, a gift certificate, and a coupon (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Re Claim 12: Doggett in view of Radecki discloses the claimed method supra and Doggett discloses a method further comprising a step of electronically notifying at least one of the payor and payee of the payment instrument, wherein the electronic notification includes at least one of a web page, an instant message, an e-mail message, a pager message, and a wireless phone message (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13). The phrase "at least one of" is interpreted as any member of the group but, not necessarily a plurality or all members of the group. See MPEP § 2111.

Re Claim 13: Doggett in view of Radecki discloses the claimed method supra and Doggett discloses, wherein the server computer system comprises a plurality of

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computers coupled together by a computer network (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Re Claim 14: Doggett in view of Radecki discloses the claimed method supra and Doggett discloses, wherein the first handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13). The phrase "at least one of" is interpreted as any member of the group but, not necessarily a plurality or all members of the group. See MPEP § 2111.

Re Claim 16: Doggett in view of Radecki discloses the claimed method supra and Doggett discloses, wherein the credit amount corresponds to at least one of: currency, monetary value, airline mileage, promotional program points, gift certificate credit, and commodities (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13). The phrase "at least one of" is interpreted as any member of the group but, not necessarily a plurality or all members of the group. See MPEP § 2111.

Re Claim 17: Doggett in view of Radecki discloses the claimed method supra and Doggett discloses a method further comprising steps of:

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retrieving a trigger condition that initiates the second-listed transferring step (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13); and determining when the trigger condition is satisfied (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Re Claim 18: Doggett in view of Radecki discloses the claimed method supra and Doggett discloses, wherein the trigger condition includes at least one of: a credit balance in the stored value fund meeting a threshold; and a period of time expiring (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13). The phrase "at least one of" is interpreted as any member of the group but, not necessarily a plurality or all members of the group. See MPEP § 2111.

Re Claim 19: Doggett in view of Radecki discloses the claimed method supra and Doggett discloses, wherein the payor, the first handler, the second handler and the payee are remotely located with respect to each other (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Radecki as applied to claims 10 above and further in view of Bator, US Pat. No. 6,575,362.

Re Claim 15: Doggett in view of Radecki discloses the claimed method supra.

Doggett fails to explicitly disclose wherein the second handler includes at least one of a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer.

Bator discloses, wherein the second handler includes at least one of a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer (Bator, abstract, col. 1, line 1+ - col. 3, line 50; col. 4, line 44+ - col. 5, line 18; col. 10, line 10+ - col. 8, line 30; col. 9, line 41 – col. 10, line 30). The phrase “at least one of” is interpreted as any member of the group but, not necessarily a plurality or all members of the group.

See MPEP § 2111. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Doggett by adopting the teachings of Bator to provide wherein the second handler includes at least one of a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer.

As suggested by Doggett one would have been motivated to provide substitutes for checks that were safer and posed less of a security risk.

Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett, US Pat. No. 5,677,955 in view of Perazza, US Pat. No. 5,326,959.

Re Claims 21: Doggett discloses a method for transferring a credit amount out of an online system using a payment instrument, the method comprising:

receiving pay-out instructions at a server computer system from a wide-area computer network coupled to a payor, wherein the pay-out instructions are chosen from a group consisting of at least two of a payee, a delivery location, and the credit amount (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31;

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col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

determining a first handler associated with the payor (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

transferring the credit amount from the first handler to the online system (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

storing the credit amount in a stored value fund associated with one of the payor and payee (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13);

determining a second handler for preparation of the payment instrument according to the pay-out instructions (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13), wherein:

the second handler is one of a plurality of second handlers (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13), and

the second handlers is chosen from a group consisting of:

at least one of a debit card handler, a bank handler, and a credit card handler (Doggett,

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abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

sending the pay-out instructions to the second handler (Doggett, abstract, Figs.

1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20;

col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13); and

transferring the credit amount from the stored value fund to the second handler

(Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Doggett fails to explicitly disclose:

at least one available second handler is chosen from a second group consisting of a promotion handler and a money order handler.

Perazza discloses:

at least one available second handler is chosen from a second group consisting of a promotion handler and a money order handler (Perazza, col. 1, line 1+ - col. 3, line 57; col. 5, lines 15-25; col. 7, lines 9-53; col. 8, lines 28-35; col. 13, lines 60+ - col. 14, line 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Doggett by adopting the teachings of Perazza to provide at least one available second handler is chosen from a second group consisting of a promotion handler and a money order handler.

One would have been motivated to provide the payor and payee with safer and more trusted means of transfer.

Re Claim 22: Doggett discloses in view of Perazza discloses the claimed method supra and Doggett discloses, wherein the payment instrument is chosen from the group consisting of: a money order, a cashiers check, a tellers check, a certified check, a gift certificate, and a coupon (Doggett, abstract, Figs. 1,2,3,6,11,12,13,14,15; col. 1, lines 1+ - col. 4, line 31; col. 5, line 10+ - col. 6, line 20; col. 7, line 13+ - col. 10, line 57; col. 16, line 42+ - col. 18, line 13).

Response to Arguments

IDS

Confirmation submitted

Double Patenting

Withdrawn

102/103

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues, the prior art does not teach the use of an internally managed stored value fund.

Examiner notes nothing in the claimed invention requires that the stored value fund is internally managed and nothing in the claim describes attributes that are advantageous or novel to an internally managed stored value fund versus any stored value fund.

Furthermore, the portion of the claim limitation that recites the active step to be performed (i.e., "storing the credit amount in the temporary stored value fund"), is accomplished by Doggett. See also citations supra.

Applicant argues, the prior art does not teach a plurality of first handlers and a plurality of second handlers.

As discussed supra, only a single first handler and a single second handler has any role or function in the claimed invention as defined by the active steps performed. See also citations supra.

Applicant contends that the prior art does not teach using multiple types of handlers. Examiner notes the cited portions of Doggett however, do teach multiple types of handlers. The claimed invention has placed these different types of handlers into two groups however, the significance, advantage or novelty afforded from having two groups is unclear. As discussed supra, the way the claims are presently drafted it is not necessarily required that the handlers are even drawn from one of and/or both of the groups. See also citations supra.

In applicants remarks several references are made to subject matter that can be found in the specification. In response to applicant's arguments that the references fail to show certain features of applicant's invention, it is noted that these features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation given for obviousness rejections can either be found within the references themselves or knowledge generally available to one of ordinary skill in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

"Connect now with electronic commerce," by Jack Large. Corporate Finance. London: Jul 1998., Iss. 164.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

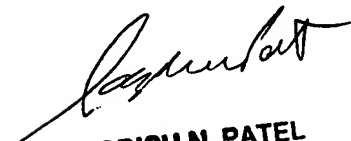
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC



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